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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/630,034 | 07/30/2003 | William D. Honnick | IR 3448A (1222.0100-01-00 | 7768 |

34986 7590 06/05/2006

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| EXAMINER | |
|---|---|
| LEADER, WILLIAM T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1742 | |

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/630,034 | HONNICK, WILLIAM D. | |
| | Examiner | Art Unit | |
| | William T. Leader | 1742 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *40 and 42-52* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *40* is/are allowed.

6)☒ Claim(s) *42-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. Receipt of the papers filed on March 17, 2006, is acknowledged. Claims 40 and 42-53 are pending.

2. The terminal disclaimer filed on March 17, 2006, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of the full statutory term shortened by any terminal disclaimer of prior patent No. 6,669,835 has been reviewed and is accepted. The terminal disclaimer has been recorded.

3. In view of the terminal disclaimer, the double patenting rejection of claim 40 is withdrawn. Claim 40 is allowed.

4. Claims 42-52 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Harris et al (5,672,432) for the reasons given in the previous office action and in view of the following comments.

5. Claims 42-52 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Doshi et al (4,341,689) for the reasons given in the previous office action and in view of the following comments.

6. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris et al (5,672,432) combined with Doshi et al (4,341,689) for the reasons given in the previous office action and in view of the following comments.

7. Applicant's Remarks have been carefully considered but are not deemed to be persuasive. At page 7 applicant argues that the claims distinguish both Harris and Doshi for failing to teach or suggest the core concept of the invention, a product produced by the process of electrocoating polymerizable reactants in an aqueous medium having a metal containing catalyst with a water solubility of less than 1% by weight in water at 25°C sorbed onto an inorganic particulate carrier having a particle size less than 100 microns or less than 20 microns the catalyst being a liquid when sorbed, and subsequently curing the coating. Applicant's discussion describes the *process* by which the product is made. However, claims 42-53 are directed to a *product*, not a process. Examination of such product-by-process claims is discussed in MPEP 2113. The MPEP explains:

> "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

8. Applicant states that Harris does not show applicant's first step of combining the tin catalyst with the pigment and then adding it to the pre-polymer as in the present invention, and points to examples 3 and 3A of the present application as clearly showing that by combining a tin catalyst with a pigment to obtain a catalyst sorbed onto the surface of the pigment and then adding it to a pre-polymer results in coating compositions that reduce surface imperfections. Examples 3 and 3A have been considered but are not deemed to show that the product of the instant claims differs from that of the references. The results of examples 3 and 3A are shown in Table 2. Stability and initial quality of examples 3 and 3A are the same. Table 2 does

demonstrate a difference after 1 week and 2 weeks. However, there appears to be no difference in the products produced when the baths were fresh. Additionally, these examples do not demonstrate that the claimed product differs from those of Harris, Doshi or Harris combined with Doshi, particularly if the products of the references are produced when the baths are fresh.

9. At page 8 applicant states that the rejection over Doshi also fails to teach or suggest the invention for substantially the same reasons as Harris. This argument is not persuasive for the reasons given with respect to Harris. At page 10 applicant argues that a skilled artisan would not combine the teachings of Harris and Doshi since it would eliminate any extended pot-life. While this advantage might not be obtained, other advantages such increased reaction rate or better dispersion of the amine catalyst would have been obtained.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 571-272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Leader
May 25, 2006

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700